

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 15-18, 20-25, 27-32, 38-51, 56-57, 59 and 64-70 are presently active in this case. The present Amendment amends Claims 21-22; and adds new Claims 69-70 without introducing any new matter.

The outstanding Office Action rejected Claims 15-16, 18, 20-23, 25, 27-32, 38-39, 41-47, 49, 56-57, 59, 64-68 under 35 U.S.C. §102(a) as anticipated by Ludwig (U.S. Patent No. 6,256,498). Claims 17, 24, 51 were rejected under 35 U.S.C. §103(a) as unpatentable over Ludwig in view of Park (U.S. Patent No. 5,627,549). Claims 40, 48, 50 were rejected under 35 U.S.C. §103(a) as unpatentable over Ludwig and Park and further in view of Lyons (U.S. Patent No. 6,282,412).

To correct minor formalities, Claims 21-22 are amended. Since the changes are only formal in nature, they are not believed to raise a question of new matter.

In response to the rejection of Claims 15-32 under 35 U.S.C. §102(e) over Ludwig, Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, independent Claim 15 relates to a mobile device, including a receiver configured to receive program-accompanying digital data; a position locating module configured to determine a current geographic position of the mobile device; a filter module configured to filter location-specific information from the program-accompanying digital data based *at least on the location parameters and the current geographic position*; and a communications module configured to transmit the *location-specific information* from the mobile device to a service center.

As explained in Applicant's Specification at page 2, lines 1-28 with corresponding Figure 1, Applicant's invention improves upon conventional mobile devices because the user can define certain categories or subject areas he is interested in by a user profile. It is thereby possible to filter out location-specific information of the location of the mobile device, which are related to these categories or subject areas defined by the user.

Turning now to the applied reference, Ludwig describes a World Wide Web (WWW) service for a mobile device connected to a mobile station, wherein based on the location of the mobile device, location-dependent WWW services are provided to the mobile device by a server.¹

However, Ludwig fails to teach or suggest at least a filter module configured to filter location-specific information from the program-accompanying digital data based at least on the location parameters and the current geographic position, as recited in Applicant's Claim 15. Although Ludwig recites that "[a] location data filter selects location specific data from the received broadcast information that is received via the plurality of base station subsystems,"² Ludwig's location specific data is related to the geographic location of the mobile station, since Ludwig defines that "[t]he location specific information is exchanged with a mobile device MD that uses this information to either estimate the geographic position or ... to a WWW server that may then estimates [sic] the required geographical location,"³ and thereby explains that "the mobile station MS always has exact information about its own current location within the GSM service area."⁴

Accordingly, Ludwig's location specific information is geographic location information of current location of the mobile station.⁵ Ludwig also explains that the location data filter 6 identifies a longitude and latitude information for each adjacent cell, being

¹ See Ludwig in the Abstract.

² See Ludwig at column 3, lines 39-43.

³ See Ludwig at column 61-67.

⁴ See Ludwig at column 6, lines 54-56.

⁵ See Ludwig, for example at column 6, lines 49-56.

Ludwig's location specific information.⁶ However, Applicant's Claim 15 recites "a filter module configured to filter location-specific information from the program-accompanying digital data based at least on the location parameters *and* the current geographic position" (emphasis added). Longitude and latitude information from a base station, used to calculate current location coordinates,⁷ as taught by Ludwig, *is not* location specific information, as recited in Applicant's Claim 15.

Applicant respectfully notes that the outstanding Office Action appears to suggest that the teaching "location data filter (6) adapted to select location specific data from the received broadcast information" stated in Ludwig's Abstract and in the summary of the invention, can be considered out of context, but this is contrary to established precedent. In this respect, see *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ 1313, 1317 (Fed. Cir. 2000), to recite "... reference statements cannot be viewed in the abstract. Rather, they should be considered in the context of the teaching of the entire reference." Even if Ludwig's location specific data would read upon Applicant's current geographic position, Ludwig still fails to teach or suggest location-specific information.

In this regard, MPEP §2111.01 III explains that Applicant may be his own lexicographer. Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Applicant's specification explains at page 6, lines 7-14 in a non-limiting example that "program-accompanying data can be passed on as location-specific information," and Applicant's specification explains at page 8, lines 5-9 that the "location specific data contain order numbers for products, services and/or

⁶ See Ludwig at column 7, lines 36-42 and in corresponding Figure 7.

⁷ See Ludwig at column 6, lines 49-56.

information requests, which include a product identification of the respective product, services or information requests.”

Accordingly, a similar feature regarding the location-specific information is now recited in new dependent Claims 69 and 70, depending upon independent Claims 15 and 22, respectively. Since new Claims 69-70 find non-limiting support in the specification as originally filed, for example at page 8, lines 5-9, they are not believed to raise a question of new matter.

Therefore, in view of the above discussion, Applicant respectfully submits that Ludwig fails to teach or suggest all the elements of independent Claim 15, and therefore Applicant believes that Claim 15 is patentably distinct over Ludwig. Therefore, Applicant requests reconsideration of the rejection under 35 U.S.C. §102(e).

In addition, Applicant respectfully submits that Ludwig also fails to teach or suggest features of the dependent claims, as next discussed.

Regarding Claim 20, Ludwig fails to teach or suggest that the location-specific information includes an URL address. The outstanding Office Action points out to Ludwig at column 2, lines 55-59 and asserts that Ludwig teaches such a feature.⁸ Applicant respectfully disagrees. In this passage, Ludwig merely explains that a protocol underlying the WWW is an HTTP protocol and a principle about WWW server/client request.⁹ As discussed above, Ludwig describes in Figure 7, that the WWW application running on the mobile device MD can send information on its location to a WWW server, and the WWW server will be able to provide “location sensitive websites based on latitude and longitude.”¹⁰ Therefore, Ludwig fails to teach or suggest that the location specific information includes an URL address.

⁸ See the outstanding Office Action, at page 3, lines 9-12.

⁹ See Ludwig at column 2, lines 50-55.

¹⁰ See Ludwig at column 9, line 15.

Regarding Claim 21, Ludwig also fails to teach or suggest a processing module configured to execute program data files included in the location-specific information. The outstanding Office Action rejects Applicant's Claim 21 based on Ludwig's teachings at column 4, lines 38-47. Applicant again respectfully disagrees, since in this passage, Ludwig merely explains that different types of applications and services can be run on mobile devices. Such teaching does not read upon a processing module configured to execute *program data files included in the location-specific information*.

Applicant also believes that dependent Claims 29, 41-42, 46 and 66 recite features neither taught nor suggested by Ludwig, and therefore respectfully requests proper examination of the dependent claims on the merits.

Therefore, Applicant believes that also the dependent claims recite features neither taught nor suggest by Ludwig, and therefore request reconsideration of the rejection of the dependent claims.

Regarding the rejection, of Claims 17, 24, 40, 48 and 50-51 under 35 U.S.C. §103(a), Applicant respectfully submits that the reference Park and Lyons, relied upon by the outstanding Office Action to form the 35 U.S.C. §103(a) rejections, fail to remedy the deficiencies of Ludwig, as next explained.

Park discloses a vehicle information device for showing direction and distance of travel to a designated geographic location.¹¹ In Park, multiple geographic points of interest are stored for *selective review by the user*.¹² However, Park also fails to teach or suggest a filter module configured to filter location-specific information from the program-accompanying digital data based at least on the location parameters and the current geographic position, as recited in independent Claim 15. In Park, the user himself "collects advertising information for vendors in close and convenient proximity to current vehicle

¹¹ See Park in the Abstract.

¹² See Park in the Abstract, lines 13-16.

location.”¹³ Park’s user thereby designates filtering criteria, and the filtering criteria disclosed are: types of products or advertised services.¹⁴ In other words, and as shown in Park’s Figure 3, Park’s user needs to identify the location of the geographic point of interest 100a manually,¹⁵ and can thereby use the vehicle’s GPS receiver 80 to identify the current vehicle location 82.¹⁶ Accordingly, Park fails to teach or suggest a filter module using the current geographic position. Applicant’s invention has as a goal to solve the deficiencies of Park, since Park’s user himself “builds a personalized and current database of geographic points of interest,”¹⁷ while in Applicant’s invention, “a user of this mobile device can be supplied with *location specific information* in a targeted way” (emphasis added), as stated in Applicant’s specification at page 2, lines 8-10.

The reference Lyons also does not remedy the deficiencies of Ludwig since Lyons merely explains that stations serve a user-designated geographic area. Therefore, Lyons fails to teach or suggest a filter module configured to filter location – specific information from the program-accompanying digital data based at least one the location parameters and the current geographic position.

Therefore, even if the combination Ludwig and Park and/or Lyons is assumed to be proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.¹⁸

Independent Claim 22 recites features analogous to the features of independent Claim 15. Accordingly, in view of the above discussion regarding patentability of independent

¹³ See Park at column 8, lines 59-62.

¹⁴ See Park at column 8, lines 62-67.

¹⁵ See Park at column 6, lines 59-62.

¹⁶ See Park at column 5, lines 11-16 and in Figure 2.

¹⁷ See Park at column 6, lines 63-65.

¹⁸ See MPEP 2142 stating, as one of the three “basic criteria [that] must be met” in order to establish a *prima facie* case of obviousness, that “the prior art reference (or references when combined) must teach or suggest all the claim limitations,” (emphasis added). See also MPEP 2143.03: “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

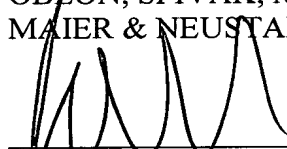
Claim 15, Applicant believes that Claim 22, and all associated dependent claims, patentably define over the applied references Ludwig, Park and Lyons, even if *in arguendo* the combination is assumed proper.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 15-18, 20-25, 27-32, 38-51, 56-57, 59 and 64-70 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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